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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,523	11/12/2003	Robert Fu	TRAN-P196	8679

7590 08/29/2006  
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EXAMINER

MONDT, JOHANNES P

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/712,523	<b>Applicant(s)</b> FU ET AL.	
	<b>Examiner</b> Johannes P. Mondt	<b>Art Unit</b> 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/24/06 and 11/22/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is in response to a request by applicant's representative to withdraw the finality of the office action mailed 6/8/06. Said request is hereby complied with: the finality of the office action mailed 6/8/06 has been withdrawn and said office action is herewith being replaced with this office action. It is noted that compliance is exclusively due to an indication of persuasiveness of arguments in the election-of-species requirement mailed in between the non-final and final office actions (mailed 6/3/05 and 6/8/06, respectively).

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 1-3*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art as Admitted by Applicant in view of Reczek et al (4,798,974). Art disclosed as Prior Art as Admitted by Applicant (APAA) teaches a first control input coupled to a first N-well bias supply line through 150a or 150b (see Figure 2 and page 2, line 18 – 21); and a second control input coupled to a substrate bias supply line through 155a or 155b (see Figure 2 and page 2, line 21 – page 3, line 1).

*APAA does not necessarily teach* the limitation of "a switched terminal coupled to ground and to the substrate bias supply line and output terminal coupled to a P-type substrate". However, it would have been obvious to include said limitation in view of

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Reczek et al, who, in a patent on CMOS circuitry with substrate bias supply line (line from  $V_{DD}$  to 16 and from 16 through 17 to substrate: Figure 1) coupled to second control input ('BIAS VOLTAGE GENERATOR' 16, see Figure 1 and col. 4, l. 27-33), hence closely related to APAA (see Reczek et al, title, abstract, col. 1, l. 8-28 ) teach a switched terminal (electronic switch T4) coupled to ground  $V_{ss}$  (loc.cit.) and a switched terminal coupled to said substrate bias supply line (i.e., the electrical line connecting 16 with  $V_{DD}$ ; loc.cit.) and an output terminal (terminal of 16 on the side of 17) coupled to a P-type substrate (col. 3, l. 17-21), for the specific purpose of discharging potentially damaging powerful currents via additional circuitry (col. 5, l. 14-22). Because both APAA and Reczek et al are relevant during a situation in which a positive supply voltage is switched on (see page 3 of the specification and see Reczek et al, col. 1, l. 29-59) for which Reczek et al provide a remedy as delineated above, there is ample motivation to combine the teaching by Reczek et al with the APAA. All that is needed for the combination is the insertion of said switch between the bias supply line, output terminal and ground, which is straightforward in the art.

*On claim 2:* said switch is operable in the combined invention to electrically couple said P-type substrate to said ground when a bias voltage is present on said first N-well bias supply line (i.e., line 14 in Reczek et al, cf. col. 3, l. 52-54 and col. 5, l. 14-20).

*On claim 3:* said switch is operable to electrically couple said P-type substrate to said substrate bias supply line when a substrate bias voltage is present on said substrate bias supply line (loc.cit.) ( $V_{DD}$  is the very supply voltage that is switched on, for

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which operation the electronic switch T4 is inserted: see col. 1, l. 29-59 and col. 3, l. 52-54).

3. **Claims 4-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over APAA and Reczek et al as applied to claim 4 above, and further in view of Nakazato et al (5,386,135). As detailed above, claim 1 is unpatentable over APAA in view of Reczek et al. Neither necessarily claim the further limitations defined by claims 4, 5, 6, 7 or 8. However, it would have been obvious to include said further limitation ad claim 4 as it has long been recognized in the art of CMOS memory devices to provide separate, i.e., independent, bias to their individual N wells (Figure 33) so as to improve the overall breakdown voltage (col. 6, l. 45-61). *Motivation* exists to apply the invention defined by APAA and Reczek et al to any CMOS circuit, in particular to those in semiconductor memory devices in which there are many N-wells as shown by Nakazato et al, wherein the resulting improvement of overall breakdown voltage (loc.cit.) forms an obvious motivation.

*On claim 5:* in the combined invention said switch is operable to electrically couple said P-type substrate to said ground when a bias voltage is present on said second N-well bias voltage supply line and when it is not present, the relation between the second N-well well bias supply voltage not being of any influence to the switch position by virtue of the independence of the first and second N-well bias voltage supplies as taught by Nakazato et al (loc.cit.).

*On claim 6:* said switch is operable to electrically couple said P-type substrate to said substrate bias supply line when a substrate bias voltage is present on said

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substrate bias supply line (loc.cit.) ( $V_{DD}$  is the very supply voltage that is switched on, for which operation the electronic switch T4 is inserted: see col. 1, l. 29-59 and col. 3, l. 52-54).

*On claims 7-8:* in the combined invention by APAA, Reczek et al and Nakazato et al of which the obviousness was discussed above the voltage of the substrate bias supply line and the N-well bias supply lines are independent because of the independence of the N-well bias supply lines with respect to each other. Therefore, said switch in the combined invention is operable to electrically couple said P-type substrate to either said substrate bias supply line (claim 7) and ground (claim 8) when a substrate bias voltage is present on said substrate and there is no bias voltage present on said N-well line, the substrate bias supply line voltage  $V_{DD}$  being an evaluation parameter for operating the switch and the presence or absence of a voltage on the N-well bias line being independent of switch operation, being independent of  $V_{DD}$  and ground.

### ***Response to Arguments***

Applicant's arguments filed 8/30/05 have been fully considered but they are not persuasive. In particular:

In response to applicant's pre-amble-like argument (Remarks page 2) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's

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disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Inserting a switch between three terminals is an example of knowledge available within the level of ordinary skills in the art, the more so in the underlying case because of explicit teaching of the resultant structure and its advantages by Reczek.

In specific response to the arguments of traverse the following comments are offered:

Claim 1:

(1.1) On applicants' argument of traverse of the rejection of claim 1 based on an alleged deficiency in the teaching of the primary reference (see Remarks page 3), i.e., "APA" ("APAA" in the rejection): applicants' arguments relying on an alleged recitation "control inputs (to switch)" (sic) is not persuasive at least because no such recitation can be found in the claim. Applicants furthermore fail to explain any structural difference between the claimed components and those in the "APA" identified therewith in the rejection.

(1.2) With regard to applicants' arguments (page 2 of Remarks) that the rejection "creates an embodiment of the present invention from the cited art when no such suggestion or teachings exist therein", with reference to one sentence from the rejection merely aiming at explaining how to build the combination, ignores the detailed motivation for including the teachings by Reczek, specifically based quotes from Reczek, about which no comment can be found in said Remarks (the "why" of applicants, Remarks, page 2 final line), while applicants fail to convey why it would not

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be straightforward to insert a switch between three terminals, which is what the accused sentence in the rejection asserts to be within the ordinary skills in the art.

(3) With regard to applicants' argument in traverse of the rejection of claim 1 based on an alleged distinction in the art between a "switched terminal coupled to a ground" and Reczek's FET (field effect transistor) T4, see Remarks pages 3-4, any FET is a switched terminal in the sense of the specification, considering the gate and its functionality to switch between ON and OFF, while additionally FET T4 in Reczek is coupled to ground, directly so in the OFF state of generator 16 (see column 3, lines 55 – 66) and through generator 16 in any case. Even arguendo, in this regard it is noted that the invention by its presentation through claims 1-8 is a product, while whether or not switch T4 is directly or indirectly coupled to ground is a matter of use of the product, and without patentable weight to the product invention. Applicants are reminded in this regard that intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

In view of the above considerations the rejection of claim 1 stands.

Claim 2:

(2.1) The only argument in traverse of the rejection of claim 2 addressed to the further limitation defined by claim 2 relies on an alleged distinction between a "supply voltage to a well" and an alleged "selective coupling" as claimed based on said supply



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voltage being “fixed” (Remarks page 4). However, applicants’ argument at most is based on a distinction between different methods of use of the product rather than the product (switch as claimed). The only question is whether the device is operable in the manner claimed because in reference to the claim language referring to “to electrically couple said P-type substrate to said substrate bias supply line when a bias voltage is present on said substrate bias supply line”, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

In the underlying case the selection  $V_{DD} = V_{SS}$  satisfies the claim limitation.

In view of the above considerations the rejection of claim 2 stands.

Claim 3:

(3.1) Applicants’ argument (Remarks page 5), aside from a mere statement of lack of understanding, relies wholly on those made on FET T4 in the traverse of the rejection of claim 2, and therefore is equally unpersuasive.

Therefore, the rejection of claim 3 stands.

Claim 4:

(4.1) Claim 4 merely recites in its further limitation a “second control input coupled to a second N-well bias supply line”, therefore applicants’ arguments (Remarks pages 6) are based on an exaggeration of what is needed from Nakazato et al to supplement the references of the independent claim 1: Nakazato teaches the

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advantage of controlling the voltage on separate N-wells individually, which Nakazato et al do, by teaching, as well as by providing motivation, namely the improvement of the breakdown voltage, as pointed out in the rejection.

Therefore, the rejection of claim 4 stands.

Claim 5:

(5.1) The further limitation defined by claim 5 merely extends the further limitation by claim 2 to the case of a *second* N-well, while the plurality of N-wells, and motivation for their *separate* control, is taught by Nakazato et al. For this reason, as in the case of the arguments in traverse of claim 4, applicants appear to exaggerate what needs to be learnt from Nakazato et al, with reference to the discussion overleaf of the traverse of the rejection of claim 4.

Therefore, the rejection of claim 5 stands.

Claim 6:

(6.1) The further limitation defined by claim 6 merely extends the further limitation by claim 3 to the case of a *second* N-well, the plurality of which, and motivation for their *separate* control, is taught by Nakazato et al. For this reason, as in the case of the arguments in traverse of claim 4, applicants appear to exaggerate what needs to be learnt from Nakazato, with reference to the discussion overleaf of the traverse of the rejection of claim 4.

Therefore, the rejection of claim 6 stands.

Claims 7-8:

(7/8.1) Rather than invent a switch where there is none as applicants appear to allege, Reczek et al do teach said switch, as already indicated both in the rejection and overleaf (see discussion of claim 1); neither is there a need to “invent” functions for said switch, “functions for said switch” not being claimed; T4 is clearly operable to electrically couple substrate to ground through generator 16, depending on the setting of 16; a substrate bias voltage is present, its value being a variable in the operation of the device and hence of no patentable weight, while “no bias voltage” has been interpreted to mean ground ( $V_{SS}$ ), which clearly is a permissible value for  $V_{DD}$ .

In view of the above, the rejections of claim 7 and 8 stand.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt whose telephone number is 571-272-1919. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JPM  
August 22, 2006

Patent Examiner:

A handwritten signature in black ink, appearing to read 'J. Mondt', with a stylized flourish at the end.

Johannes Mondt (Art Unit: 3663)